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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/483,728 | 01/14/2000 | Yoshiaki Saita | S004-3288(DIV) | 8760 |
| 7590 | 12/22/2003 | | EXAMINER | |
| Bruce L. Adams Adams & Wilks 50 Broadway, 31st Floor New York, NY 10004 | | | TUGBANG, ANTHONY D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3729 | |

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 09/483,728 | SAITA ET AL. |
| Examiner | Art Unit | |
| | A. Dexter Tugbang | 3729 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 October 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) _____ is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. 08/944,662.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). ____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6) Other:

DETAILED ACTION

Election/Restrictions

1. Upon further consideration by the examiner, the previous Restriction Requirement (Paper No. 5, dated 12/3/01) is hereby withdrawn in view of the following.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to a thermal head, classified in class 347, subclass 209.
 - II. Claims 4-12, drawn to a process of making a thermal head, classified in class 29, subclass 611.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Group II and I are related as process of making and product made, respectively. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process of Group II can be used to make a materially different product, such as one that includes a plurality of electrodes or a protective sealing element. The product of Group I does not require any electrodes or any protective sealing element and an “encapsulation portion” is not necessarily the same materially as a “protective sealing element”.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. If applicants' elect the invention of Group II, then a restriction to one of the following inventions is required under 35 U.S.C. 121:

- II-A. Claims 4 and 5, drawn to forming pairs of electrodes, classified in class 29, subclass 831.
- II-B. Claims 6 and 7, drawn to forming pairs of heaters, classified in class 29, subclass 611.
- II-C. Claims 8-12, drawn to forming a protective sealing or encapsulation element either contiguous or extending to a peripheral edge of the substrate, classified in class 29, subclass 841.

The inventions are distinct, each from the other because of the following reasons:

- 6. Inventions of Groups II-A, II-B and II-C are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case for example, the invention of Group II-A has separate utility such as a process of forming pairs of electrodes with each pair being disposed symmetrically with respect to the formation of grooves. See MPEP § 806.05(d).
- 7. Because these inventions are distinct for the reasons given above and the search required for Group II-A is not required for Groups II-B and II-C, the search required for Group II-B is not required for Groups II-A and II-C, and the search for Group II-C is not required for Groups II-A and II-B, restriction for examination purposes as indicated is proper.
- 8. A telephone call was made to Bruce L. Adams on December 18, 2003, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

December 18, 2003